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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,436	09/30/2003	Mitsunobu Usui	Q77416	2614

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EXAMINER

WATKO, JULIE ANNE

ART UNIT PAPER NUMBER

2653

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/673,436

Applicant(s)

USUI, MITSUNOBU

Examiner

Julie Anne Watko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09/30/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
2. Applicant cannot rely upon the foreign priority papers to overcome any rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

### ***Information Disclosure Statement***

3. The information disclosure statement filed September 30, 2003, fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The copy of JP 11-175951 provided by Applicant is incomplete. The Examiner has provided a complete copy and cited the reference on form 892.

### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: CT1 and CT2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application

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must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The disclosure is objected to because of the following informalities:

On page 1, lines 25-6, the specification recites "a weft consisting of an ultra fine fiber is exposed more outside than a warp and it is arranged vertically for a running direction". This is inconsistent with page 2, lines 2-3, in which the specification recites "the warp is vertically arranged for the running direction of the tape".

Appropriate correction is required.

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "weft is vertically arranged for a running direction of said tape" in the last 2 lines. The limitation "vertically arranged" is ambiguous. It is noted by the Examiner that the running direction of the tape is a vertical direction in Fig. 1, but a horizontal

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direction in Fig. 2 of Applicant's specification. It is unclear whether the limitation "vertically arranged for a running direction" refers to a vertical direction parallel to the vertical running direction as in Fig. 1, or with a vertical direction perpendicular to the horizontal running direction as in Fig. 2.

The Examiner suggests the use of the terms "parallel" or "perpendicular", as appropriate.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 4 and 7 are rejected, to the extent understood, under 35 U.S.C. 103(a) as being unpatentable over Kao (JP 11-175951) in view of Fritsch (US Pat. No. 4916564).

As recited in claim 1, Kao shows a tape cleaner which comprises a cleaning tape (13A-B) to wipe out dirt adhered to a surface of a tape and is composed to wipe out the dirt adhered to the surface of said tape by pressing said cleaning tape on a surface of a running tape. Kao also teaches the use of a woven fabric as the cleaning tape.

As recited in claim 1, Kao is silent regarding whether wherein said cleaning tape is composed so that a weft made of an ultra fine fiber is exposed more outside than a warp, and the web is vertically arranged for a running direction of said tape.

As recited in claim 1, Fritsch teaches that a weft is exposed more outside than a warp ("satin in the material provides smoothness to reduce the friction", see col. 2, lines 3-4).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to use satin as the cleaning material in the tape cleaner. The rationale is as follows: one of ordinary skill in the art would have been motivated to provides smoothness to reduce the friction so as to avoid wear upon the cleaned part as taught by Fritsch.

Regarding the limitations “ultra fine”: The law is replete with cases in which when the mere difference between the claimed invention and the prior art is some range, variable or other dimensional limitation within the claims, patentability cannot be found.

It furthermore has been held in such a situation, the Applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Moreover, the instant disclosure does not set forth evidence ascribing unexpected results due to the claimed dimensions. See Gardner v. TEC Systems, Inc., 725 F.2d 1338 (Fed. Cir. 1984), which held that the dimensional limitations failed to point out a feature which performed and operated any differently from the prior art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use ultra fine fibers as the fibers in the cleaner of Kao. The rationale is as follows: one of ordinary skill in the art would have been motivated to arrive at the claimed dimensions through the process of routine experimentation and optimization in the absence of criticality Gardner v. TEC systems, Inc., 220 USPQ 777 (Fed. Cir. 1984).

Regarding the limitation “vertically arranged”, to the extent understood: The rearrangement of known parts does not result in a non-obvious difference absent evidence of

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unexpected results due to the rearrangement. See *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

As recited in claim 4, Kao shows that said tape is magnetic.

As recited in claim 7, Kao is silent regarding optical recording tape; however, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The claims are drawn to the cleaner, not to the recording tape. The prior art cleaner would be capable of cleaning optical recording tape.

***Allowable Subject Matter***

11. Claims 2-3, 5-6 and 8-9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hinoki et al (EP 0869481 A1) teach the use of ultrafine fiber woven fabrics as dry cleaning wipers for non-magnetic substrates in a magnetic tape forming process (see page 6, lines 56-58).

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Anne Watko whose telephone number is (571) 272-7597. The examiner can normally be reached on Monday-Thursday until 4:45PM, and Friday until 6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Julie Anne Watko  
Primary Examiner  
Art Unit 2653

December 7, 2005  
JAW

A handwritten signature in black ink, appearing to read 'Julie Anne Watko', with a large, stylized flourish at the end.